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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,237

11/19/2003

Barnett Rosenblum

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22896 7590 02/26/2007  
MILA KASAN, PATENT DEPT.  
APPLIED BIOSYSTEMS  
850 LINCOLN CENTRE DRIVE  
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EXAMINER

MARTINELL, JAMES

ART UNIT

PAPER NUMBER

1634

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/718,237

Applicant(s)

ROSENBLUM ET AL.

Examiner

James Martinell

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/15/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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Applicant's election with traverse of the requirement for restriction in the reply filed on December 14, 2006 is acknowledged. The traversal is on the ground(s) that the inventions are related, two groups are classified in the same class, and present no serious burden of search. This is not found persuasive because applicants do not address the distinctness of the inventions as outlined in the requirement for restriction mailed June 26, 2006. The search burden arises from the non-coextensive and divergent searches of the non-patent literature that are required to adequately search all of the claims. Applicants did not address the issue that Group II is classified in a different class from Groups I and III.

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 14, 2006.

The drawings are objected to for the following reasons.

- (a) Figures 2(A) through 2(E), 3(A) through 3(E), 4(A) through 4(E), and 12(a) through 12(c) should be mentioned in the Brief Description of the Drawings (see ¶¶ 0026-0039).
- (b) There are no Figures 1(b) or 1(c) in the application. Such Figures are mentioned in ¶ 0066.
- (c) Figures 2(A) through 2(D) are referred to as 2(a) through 2(d) in ¶ 0067. The notations should be made to be consistent.
- (d) Figures 4(B) through 4(E) are not discussed in the text of the specification.
- (e) Numeral 166 in Figure 7 is not mentioned in the text of the specification.
- (f) Numeral 113 in Figure 8 is not discussed in the text of the specification that deals with Figure 8 (see ¶¶ 0142-0143).
- (g) Numerals 200, 204, 208, and 212 in Figure 8 are not discussed in the text of the specification.
- (h) Numeral 310 in Figure 9 is not discussed in the text of the specification.

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- (i) Numeral 518 in Figure 9 is not discussed in the text of the specification.
- (j) Numeral 900 in Figure 14 is not discussed in the text of the specification.
- (k) There is no numeral 902 in Figure 14. See the discussion in ¶ 902.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite.

- (a) The recitation of "respective target" (claims 1, 8, and 11) is vague and indefinite because it is not clear what the antecedent for "target" is.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Grossman U.S. Patent No. 6,395,486. Grossman teaches the analysis of multiple nucleic acid targets by using mobility modifiers (*e.g.*, see the Abstract; column 1, line 60 - column 2, line 29; column 6, line 1 - column 10, line 54; and claims 1-4). The instant claims, construed broadly, embrace the methods taught in Grossman.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Grossman (U.S. Patent No. 6,395,486). Grossman teaches the analysis of multiple nucleic acid targets by using mobility modifiers (*e.g.*, see the Abstract; column 1, line 60 - column 2, line 29; column 6, line 1 - column 10, line 54; and claims 1-4). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

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This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman (U.S. Patent No. 6,395,486) in view of Pasika et al (U.S. Patent Application Publication 2002/0116135). Grossman teaches the analysis of multiple nucleic acid targets by using mobility modifiers (*e.g.*, see the Abstract; column 1, line 60 - column 2, line 29; column 6, line 1 - column 10, line 54; and claims 1-4). Pasika et al teaches automated analyses of nucleic acid information and devices for performing such analyses (*e.g.*, see the Abstract; ¶¶ 0001-0007; ¶¶ 0103-0175; ¶¶ 0270-0361; and claims 1-63). It would have been obvious for one of ordinary skill in the art at the time the invention was made to collect, analyze, and store nucleic acid data generated by the methods of Grossman using the automated methods and devices of Pasika et al for speed and accuracy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to [james.martinell@uspto.gov](mailto:james.martinell@uspto.gov). Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

#### **OFFICIAL FAX NUMBER**

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



**James Martinell, Ph.D.**  
**Primary Examiner**  
**Art Unit 1634**

2/19/07